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09/964,147	9/26/2001	Richard Davidson	2001P10389US

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REMARKS

Claims 1-24 are pending in the application. Claim 10 is amended for editorial reasons and not for patentability reasons. Claims 21-24 are newly added. No new matter is added. Reconsideration of all the claims is hereby requested in view of the following remarks.

35 U.S.C. §102(b) Rejections

The Examiner rejected claims 1-3, 12, 14 and 16 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,033,076 to Jones *et al.* ("Jones"). Applicants respectfully traverse this rejection.

For anticipation of a claim under 35 U.S.C. § 102, a single prior art reference must contain each and every limitation of the claim, either expressly or under the doctrine of inherency. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Circ), *cert. denied*, 488 U.S. 892 (1988). Applicants submit that Jones does not disclose every limitation of the claimed invention.

In regards to claims 1-3, and similarly for claims 12 and 16, each of these claims recites, in part, for example:

(i) determining whether the called party has a caller ID feature;
(ii) completing the call if such call is from a public number and the called party has the caller-ID feature; and/or
(iii) processing the call based, at least in part, on the results of these determinations.

For example, representative claim 1 includes, in part, "determining whether the called party has a caller ID feature" and "the call is from a public number" and, based on affirmative results of the determinations, completing the call. Applicants submit that Jones does not disclose these features.

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In contrast, Jones is directed to a call screening service whereby called customers receive only calls from calling customers who are willing to have their telephone number identified. When a calling customer makes a call to a called customer and the called customer has a class of service indicating that they have a screening service, the calling customer receives an announcement indicating the privacy status of the called customer. The calling customer may respond to the announcement by dialing a digit to indicate an agreement to override the caller's privacy. The class of service does not indicate caller-ID.

In another aspect that sharply contrasts Jones with the invention of claims 1-3 12, and 16, Jones checks to see if the call is private and, if not (i.e., public), completes the call, i.e., without any screening as shown by steps 203, 205 in Figure 2 of Jones. However, the invention of claims 1-3, 12, and 16 checks to see if the call is public and affirmatively checks whether the called party has caller-ID in order to decide without to complete the call without screening. Therefore, Jones does not disclose all the features of claims 1-3, 12 and 16.

The Examiner cites several passages in an attempt to support the assertion that Jones checks for caller-ID. However, a close scrutiny of these passages (or anywhere else in Jones) shows that Jones does not disclose this feature and, thus, does not show determining whether the called party has caller-ID. Moreover, since a check is not made for caller-ID, Jones does not therefore show the combination of determining whether the called party has caller-ID and determining if the call is a public number in order to complete the call based on an affirmative combined result.

Specifically, the Abstract of Jones, which was cited by the Examiner, does not disclose checking for caller-ID. Rather, the Abstract simply discloses that a customer may have a class of service indicating that the customer has the screening service. This is not determining whether the called party has caller-ID.

Further, the cited passage at col. 2, lines 44-50, also does not disclose determining whether the called party has caller ID. Rather, this passage simply states, in part, that

> "...the called customer is enabled to receive calls from callers willing to identify themselves and the privacy of the calling customer is protected since the

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calling party is identified only when the calling party specifically grants permission for such identification."

Nowhere in this passage is there a check to determine whether the called party has caller-ID as a basis for deciding whether to perform screening. It simply states the called party is enabled (i.e., via the screening class of service) to receive calls from callers willing to identify themselves. But no check is ever made to determine if the called party indeed has caller-ID. The screening service is not the same as caller-ID. The screening feature of Jones is processed whether the called party actually has caller-ID or not (assuming a private call). That is, Jones does not predicate any screening processing on whether the called party actually has caller-ID and is quite oblivious to ever checking if the called party has caller-ID. The invention of claim 1-3, 12 and 16 on the other hand, checks to see if the call is a public call and the called party has caller-ID in order to complete the call (without providing the announcement).

Similarly, at the cited passage of col. 3, lines 2-19, Jones again fails to disclose determining whether the called party has caller-ID in order to decide whether to perform screening processing. Rather, this passage only shows that the called party's class of service is consulted to decide to determine whether the called party has the screening class of service. There is no check to determine whether the called party has caller-ID.

In Jones, the screening function is always performed if the called party has the class of service and the call is a private call. Whereas, in contrast, in the invention of claims 1-3, 12 and 16, a check is made to determine whether the called party indeed has caller-ID and a check is made whether the call is public in order to complete the call, without an announcement. In Jones, a check is made to see if the called party has the screening class of service (that indicates whether the announcements are to be played or not for private calls, only). Jones is indifferent as to whether the called party actually has caller-ID or not, and as a result never provides any "screening" processing for a public call. The invention of claims 1-3, 12 and 16, on the other hand, makes a specific check to determine if the called party has a caller-ID, and provides for the possibility that announcement processing may occur when a call is public and the called party has no caller-ID. Jones is incapable of performing this function which is

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confirmed by Figure 2 of Jones where it shows that a check is made for a private call, and only when the call is private (never public), does screening occur.

As to the cited passage at col. 4, lines 12-21, this passage also does not show checking for caller-ID. Rather, this passage simply states that memory blocks are a part of the processor for storing calling party directory numbers and privacy data. Similarly, the cited passage at col. 4, lines 35-38 simply states that the system checks the class of service for the screening feature, but does not disclose checking for caller-ID.

As to the cited passage at col. 4, lines 63-68, this passage simply shows checking if the caller has requested privacy (i.e., a private call) and, if not, the call is processed conventionally. And, if the call is private, then a check is made to see if the called party has the screening class of service. But, this passage does not show checking for caller-ID. Furthermore, none of the cited column 4 passages shows the combinational requirement of checking for caller-ID and checking to see if the call is from a public number, as required by claims 1-3, 12 and 16, for "completing the call" without an announcement.

Since Jones does not disclose or suggest all the features of claims 1-3, 12 and 16, Applicants submit that the §102(b) rejections be withdrawn and that these claims are allowable. Applicants submit that claim 14 is drawn to patentable subject matter and depends from an allowable independent claim, and for at least this reason claim 14 is also allowable.

35 U.S.C. §103(a) Rejections

The Examiner rejected claims 4-11, 13, 15, 17-20 under 35 U.S.C. §103(a) as being unpatentable over Jones in view of U.S. Patent No. 5,872,840 to Wu ("Wu"). Applicants respectfully traverse this rejection.

In order to reject a claim under 35 U.S.C. §103(a), the MPEP mandates that three basic criteria must be met to provide a *prima facie* case of obviousness:

> *First, there must be some suggestion or motivation, either in the reference themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable*

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expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

Applicants submit that the references, either singly or when combined, fail to teach or suggest all the claimed features. Hence, there is no *prima facie* case of obviousness demonstrated.

As to claims 4, 5, 8-11 and 13 each of these claims recite, in variations, checking whether the called party has caller-ID feature and a call is from a public number to base further processing. As argued previously in regards to the §102(b) rejection above, Jones does not disclose or suggest at least this feature. Jones checks for a class of service that indicates whether a called party has a screening service, but Jones never checks if the called party has caller-ID.

Wu is directed to a system and method for blocking callers by a called party based on a threshold of the number of call setup requests from the calling party, perhaps within a period of time. If the threshold is exceeded, then call completions are blocked from the calling party to the called party. However, Wu does not supply the missing features of Jones (e.g., checking whether the called party has caller-ID). Moreover, neither Jones nor Wu disclose or suggest the combination of checking whether a called party has caller-ID and a call is from a public number for completing a call.

Furthermore, Applicants disagree with the Examiner's assertion that the telephone exchange of Wu qualifies as a "jurisdiction." Rather, the "requirement" being established in Wu is not a requirement established by a "jurisdiction", in the sense of the invention. The telephone exchange is simply carrying out the "requirement" (DND feature) established by the party subscribing to the DND feature.

This difference may be better appreciated by illustration. For example, arguendo, if the "same" incoming call in Wu is directed to another called subscriber (without the optional DND feature) within the so-called "jurisdiction" of the terminating telephone exchange, the call will be completed without any DND processing, because the called party has no DND feature (which is an optional feature of the telephone exchange like many other features offered by a phone company which a subscriber may optionally partake). Therefore, the telephone exchange is not exercising any "jurisdictional" requirement at all; rather it is the called subscriber that invokes a feature (i.e., an optional subscriber based feature under control of the subscriber). Simply being a feature within a telephone exchange does not automatically qualify the telephone exchange as a policy making jurisdiction in accordance with the jurisdiction of the invention. The telephone exchange in Wu is not requiring the DND processing, but

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rather it is the terminating subscriber exercising and invoking the policy requirement when subscribing and setting up the criteria of the DND feature. The telephone exchange is simply processing a "policy decision" or "requirement" of the subscriber. One or ordinary skill in the art would certainly recognize that a subscriber is not a jurisdiction in the sense of the invention.

If, arguendo, the so-called "jurisdiction" (i.e., the telephone exchange as asserted by the Examiner) were indeed establishing the requirement that "public calls to the jurisdiction had to be identifiable," then a subscriber based feature, such as the DND feature of Wu, would not be necessary or needed. If the telephone exchange were exercising "jurisdictional" requirements, any or all calls to any subscriber as determined by the "jurisdiction" (and not as established by individual subscribers who choose to partake of a feature) would automatically fall under the jurisdiction's requirement. The telephone exchange of Wu is not making any such requirements. Only calls to specific subscribers, who have decided to invoke or subscribe to an optional DND feature, are considered for processing by the DND feature. This is not "jurisdictional" control in the sense of the invention. If the so-called "jurisdiction" as proposed by the Examiner (i.e., the telephone exchange) were invoking this requirement, then "all" calls to any subscriber of the so-called "jurisdiction" would be affected, not solely calls to subscribers having chosen to subscribe to a specific optional feature that is controlled by the subscriber.

Therefore, Applicants submit that the DND feature, as disclosed in Wu, is not jurisdictional, but rather individual subscriber based, which Applicants submit does not qualify the telephone exchange in any way to be a jurisdiction, in the sense of the invention. Furthermore, the asserted so-called "jurisdiction" (i.e., telephone exchange) of Wu is not establishing or determining any requirement directed to the subject matter of the invention of claims 4, 8-11 and 13, which is a requirement that calls to the "jurisdiction" may be made only from a public number. Neither Jones nor Wu discloses or suggests this feature.

Additionally, claims 4 and 11 recite, in part,

> "screening telemarketing calls to jurisdictions where the calls may be made from only public telephone numbers."

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Applicants submit that neither Jones nor Wu discloses or suggests this feature. Neither reference concerns itself in any way with screening calls to jurisdictions where calls may be made *only* from public telephone numbers. The Examiner asserts that Wu teaches an enhanced DND list in the terminating telecommunication exchange. However, this is not in any way the same as screening calls to jurisdictions where calls may be made from *only* public telephone numbers. Wu or Jones, either singly or in combination, does not disclose or suggest determining whether calls to the jurisdiction may only be from public numbers. Jones discloses checking if a call is private to base screening decisions upon, but does not disclose checking if calls to the jurisdiction may only be from public numbers. Thus, the combination of Wu and Jones does not disclose or suggest the identical features of claims 4 and 11 for at least these reasons.

Further, in regards to claims 5 and 8 which recite "determining if a jurisdiction of a called party requires solicitor's calls to be identifiable by the called party." Once again, neither reference discloses or suggests this feature. There is no disclosure or suggestion, whatever, in either reference, singly or in combination, for "determining if a jurisdiction of a called party requires solicitor's calls to be identifiable by the called party." Wu simply discloses a DND feature to bar incoming calls that may appear on a list that a particular called subscriber establishes and controls (see col. 5, line 13-18 and col. 6, line 13-15 and Fig. 4). This is not the same as a jurisdiction making a requirement that calls to the jurisdiction has to be identifiable.

Turning now to claims 8, 9 and 10, neither the Jones or Wu reference discloses or suggests "determining whether the jurisdiction where such call is made to may be made from only a public telephone number" as recited, in part, or in variations, by claim 8, 9 and 10. Wu and Jones, either singly or in combination, do not disclose or suggest these features. The cited portion of Wu simply discloses a DND feature to bar incoming calls that may appear on a list. This is not the same as "determining whether the jurisdiction where such call is made to may be made from only a public telephone number." Neither of the references singly or in combination discloses nor suggests this feature.

Applicants submit that the §103(a) rejections over claims 4, 5, 8-11 and 13 be withdrawn and that these claims are allowable. Dependent claims 6, 7, 15-20 are drawn to patentable subject matter and depend from a respective allowable claim, and for at least this reason, claims 6, 7, 15-20 are also allowable.

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Newly Added Claims

Support for newly added claims 21-23 may be found at least at p. 5, ll. 8-15 and Fig. 2 where it shows a busy check prior to determining whether the called party has caller-ID. This passage also shows a check on a per call basis at a central office whether the call is required to be from a public number according to a jurisdiction requirement such as a state which is a governmental jurisdiction. Support for claim 24 may be found at least at Fig. 2, steps 400, 402 and other steps. Applicants submit that none of the cited references show these features.

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Conclusion

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written petition for extension of time, if needed. Please charge any deficiencies and credit any overpayment of fees to Deposit Account No. 19-2179.

Respectfully submitted,

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